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King & Spalding LLP 401 Congress Avenue Suite 3200 Austin, TX 78701			SAFAIPOUR, BOBBAK	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/511,056
Filing Date: October 11, 2004
Appellant(s): PRENZEL ET AL.

William Beard, Jr
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/18/2009 appealing from the Office action mailed 02/12/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

7127264	HRONEK ET AL	10-2006
WO 01/28171 A1	RATSCHUNAS	4-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 31-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ratschunas (WO 01/28171 A1)** in view of **Hronek et al. (US 7,127,264 B2; hereinafter Hronek)**.

Consider **claim 31**, Ratschunas discloses a method for transmitting data having multimedia content from a first communications unit (read as MMSC 2) to a second communications unit (read as MS 4) in a telecommunications network (figure 2; page 12, line 22 to page 13, line 4), the method comprising:

transmitting at least one transmission status message assigned to the data to the first communications unit (figure 2; page 12, line 22 to page 13, line 4; read as a message that the MS 4 is inactive or busy is sent); and

signaling, upon non-delivery of the data to the second communications unit, with the transmission status message, whether the data could not be delivered to the second communications unit or whether the data could have been delivered, but were not received by the second communications unit (figure 2; page 12, line 22 to page 13, line 4; If the condition is not met, a message that the MS 4 is inactive or busy is sent).

Although Ratschunas clearly discloses a non-delivery reason that the data could not be delivered to the second communications unit (figure 2; page 12, line 22 to page 13, line 4), Ratschunas fails to specifically disclose that the non-delivery reason is selected from at least two non-delivery reasons, wherein the at least two non-delivery reasons are that the data could not be delivered to the second communications unit and that the data could have been delivered, but were not received by the second communications unit.

In related art, Hronek discloses a non-delivery reason which is selected from at least two non-delivery reason, wherein the at least two non-delivery reasons are that the data could not be delivered to the second communications unit (figure 6; col. 3, lines 42-49; when the attempted delivery of the short message failed because the intended user was out of the service area) and that the data could have been delivered, but were not received by the second communications unit (figure 6; col. 3, lines 42-49; when the attempted delivery of the short message failed because the intended user had his or her communication device turned off).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the failed delivery attempts of Hronek into the method of transmitting data of Ratschunas so the source of the message may receive a status report regarding the result of the delivery.

Consider **claim 38**, Ratschunas discloses a switching arrangement for transmitting data in a telecommunications network from a first communications unit to a second communications unit, comprising an apparatus for producing a transmission status message which is assigned to the data to be transmitted to the second communications unit (figure 2; page 12, line 22 to page 13, line 4; read as a message that the MS 4 is inactive or busy is sent),

the apparatus providing a signaling, upon non-delivery of the data to the second communications unit, with the transmission status message to the first communications unit, whether the data could not be delivered to the second communications unit or whether the data could have been delivered, but were not received by the second communications unit (figure 2;

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page 12, line 22 to page 13, line 4; If the condition is not met, a message that the MS 4 is inactive or busy is sent).

Although Ratschunas clearly discloses a non-delivery reason that the data could not be delivered to the second communications unit (figure 2; page 12, line 22 to page 13, line 4), Ratschunas fails to specifically disclose that the non-delivery reason is selected from at least two non-delivery reasons, wherein the at least two non-delivery reasons are that the data could not be delivered to the second communications unit and that the data could have been delivered, but were not received by the second communications unit.

In related art, Hronek discloses a non-delivery reason which is selected from at least two non-delivery reason, wherein the at least two non-delivery reasons are that the data could not be delivered to the second communications unit (figure 6; col. 3, lines 42-49; when the attempted delivery of the short message failed because the intended user was out of the service area) and that the data could have been delivered, but were not received by the second communications unit (figure 6; col. 3, lines 42-49; when the attempted delivery of the short message failed because the intended user had his or her communication device turned off).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the failed delivery attempts of Hronek into the method of transmitting data of Ratschunas so the source of the message may receive a status report regarding the result of the delivery.

Consider **claim 32**, and **as applied to claim 31 above**, Ratschunas, as modified by Hronek, discloses the claimed invention wherein the data could not be delivered due to an

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incorrect address of the second communications unit or because the second communications unit was not available within a period of validity of the data. (Ratschunas: figure 2; page 12, line 22 to page 13, line 4; If the condition is not met, a message that the MS 4 is busy is sent)

Consider **claim 33**, and **as applied to claim 31 above**, Ratschunas, as modified by Hronek, discloses the claimed invention wherein the data were not received because they were intentionally not downloaded to the second communications unit (Ratschunas: figure 2; page 12, line 22 to page 13, line 4; the multimedia message was not sent because the condition was not met,).

Consider **claim 34**, and **as applied to claim 31 above**, Ratschunas, as modified by Hronek, discloses the claimed invention wherein the signaling comprises providing an item of information concerning the non-deliverability of the data in the transmission status message (Ratschunas: figure 2; page 12, line 22 to page 13, line 4).

Consider **claim 35**, and **as applied to claim 31 above**, Ratschunas, as modified by Hronek, discloses the claimed invention wherein the non-deliverability of the data applies if one of the correct receipt of the data and of a recipient notification message concerning the data to be transmitted to the second communications unit is not acknowledged (read as receiving condition not met) by the second communications unit via a respectively associated confirmation message (Ratschunas: figures 1-3, page 12 line 21 to page to page 14 line 9).

Consider **claim 36**, and **as applied to claim 31 above**, Ratschunas, as modified by Hronek, discloses the claimed invention wherein the telecommunications network includes a switching arrangement via which the data is transmitted from the first communications unit to the second communications unit, and wherein the switching arrangement establishes the information and signals the information with the transmission status message to the first communications unit. (Ratschunas: figures 1-3, page 12 line 21 to page to page 14 line 9)

Consider **claim 37**, and **as applied to claim 31 above**, Ratschunas, as modified by Hronek, discloses the claimed invention wherein the data is transmitted via a Multimedia Messaging Service using a Wireless Application Protocol. (Ratschunas: page 1, lines 12-28)

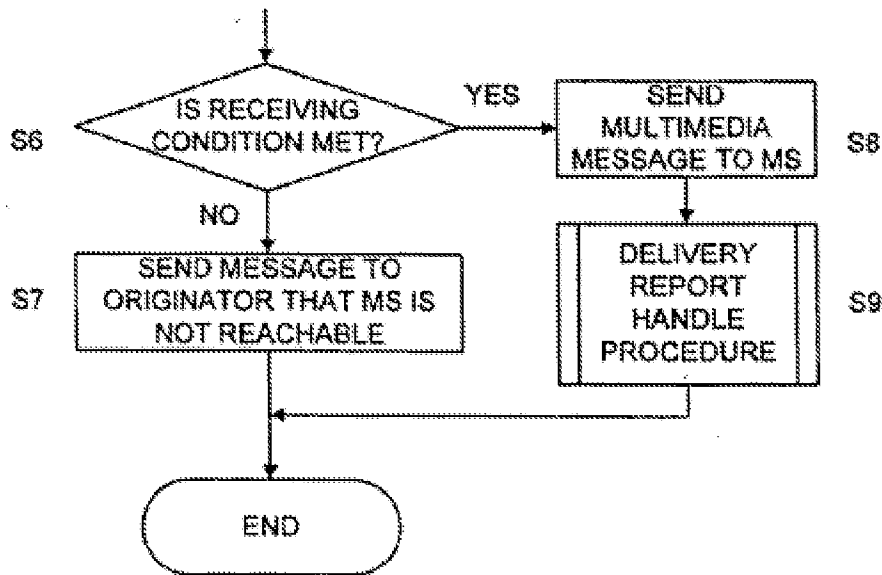
(10) Response to Argument

Applicant argues that Hronek does not teach or suggest "the transmission status message includes a non-delivery reason *which is selected from at least two non-delivery reasons*, wherein the at least two non-delivery reasons are that the data could not be delivered to the second communications unit and that the data could have been delivered, but were not received by the second communications unit."

The Examiner respectfully disagrees. The primary reference, Ratschunas, clearly discloses that the invention proposes a method for delivering messages in a network comprising at least one terminal device, comprising the steps of generating a message, setting a condition for receiving the message, deciding whether the message is to be received by the terminal device on the basis of the condition, and transmitting the message to the terminal device on the basis of the

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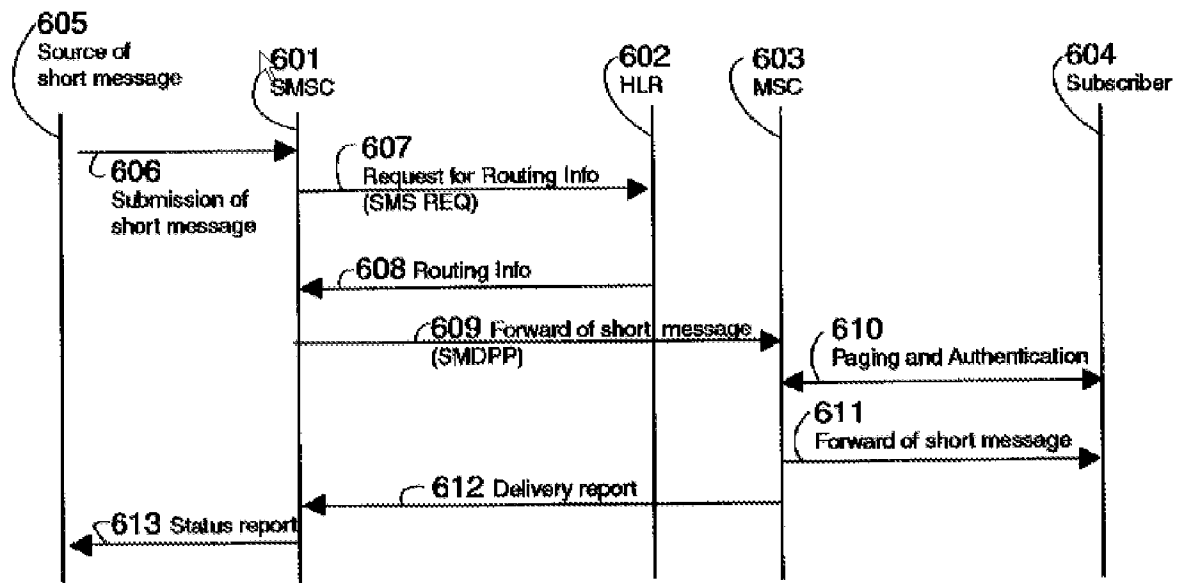
result of the deciding step. By this method, messages are only transmitted to a terminal device if certain condition. (abstract)



Ratschunas discloses in figure 2 (shown above) that if the receiving condition is not met (step s7), then a message is sent to the originator that the mobile station is not reachable.

Although Ratschunas clearly discloses a non-delivery reason that the data could not be delivered to the second communications unit (figure 2; page 12, line 22 to page 13, line 4), Ratschunas fails to specifically disclose that the non-delivery reason is selected from at least two non-delivery reasons, wherein the at least two non-delivery reasons are that the data could not be delivered to the second communications unit and that the data could have been delivered, but were not received by the second communications unit.

Taking a closer look at figure 6 of the secondary reference:



Hronek discloses the SMSC 601 receives a short message intended for a subscriber 604 from a source of short message 605, such as a device using the Short Message Peer-to-Peer (SMPP) protocol, as shown in figure 5. (col. 3, 20-23) The SMSC 601 forwards the short message to the appropriate MSC 603. (col. 3, lines 30-31) The MSC 603 delivers the short message to the intended subscriber 604, and sends a delivery report 612 to the SMSC 601. The SMSC 601 may send the result of the delivery, i.e., the status report 613 (*read as a transmission status message*), to the source of the short message 605 if requested. (col. 3, lines 37-42)

When the attempted delivery of the short message has failed (read as upon non-delivery of the data) because, for instance, the intended user was out of the service area (*read as when the attempted delivery of the short message failed because the intended user was out of the service area*), or had his or her communication device turned off (*read as when the attempted delivery of the short message failed because the intended user had his or her communication device turned off*), the MSC 603 informs the HLR 602 of the failure (*read as a non-delivery reason*). The HLR

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602 then turns on an SMS notification indicator flag for the subscriber, and the SMSC 601 retains the failed message for a later delivery attempt. (col. 3, lines 43-49)

Furthermore, the claim language of the instant application discloses that "wherein the at least two non-delivery reasons are that the data could not be delivered to the second communications unit and that the data could have been delivered, but were not received by the second communications unit." Although the claim language discloses two non-delivery reasons, one of ordinary skill in the art can correctly argue that the two non-delivery reasons are broad that a specific non-delivery reason can be read on either condition. Taking one of the examples given in the Hronek reference, if the intended user was out of the service area, this non-delivery reason could be read on either of the two non-delivery reason of the claim language, (1) the data could not be delivered to the second communications unit and (2) if the intended user out of the service area, the data could have been delivered, but the data were not received by the second communications unit due to the fact the intended user was out of the service area,. The simple fact remains that the claims only broadly recite at least two non-delivery reasons. If the Applicant intends to differentiate between that the data could not be delivered to the second communications unit and that the data could have been delivered, but were not received by the second communications unit, then such differences should be made explicit in the claims.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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/Bobbak Safaipoor/

Examiner, Art Unit 2618

Conferees:

/Matthew D. Anderson/

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